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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,679	01/14/2002	Jonathan Michael Friedman	410862000111	6606

7590 06/15/2004

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EXAMINER

BRODA, SAMUEL

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,679

Applicant(s)

FRIEDMAN ET AL.

Examiner

Samuel Broda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This communication is in response to Applicants' Response dated 1 April 2004. The Response contained no claim amendment. Claim 56 is pending.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.1 Claim 56 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This claim recites the limitation "the definition of a hierarchy of revision entries" in lines 3-4 and the limitation "the linked series of revision entries" in line 8. There is insufficient antecedent basis for each limitation in the claim.

2.2 For the purpose of further claim examination, each limitation above will be considered as defining the same feature corresponding to "a hierarchical linked series of revision entries."

Claim Rejections - 35 U.S.C. § 101

3. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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3.1 Claim 56 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3.2 Regarding independent claim 56, the claim preamble states “A revision mechanism for a modeling system, the revision mechanism being configured.” The claim limitations describe the configuration abilities of the revision mechanism but fail to include one or more limitations having a practical application providing a useful, concrete, and tangible result.

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

...

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.1 Claim 56 is rejected under 35 U.S.C. 102(b) as being anticipated by Petrie, “The Redux’ Server,” IEEE Proceedings of the International Conference on Intelligent and Cooperative Information Systems, pp. 134-143 (May 1993).

Petrie teaches use of the “Redux” server that takes objects of types defined in an ontology of decision components [corresponding to a modeling system] and maintains dependencies between them. See Abstract at page 134.

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4.2 Regarding claim 56, Petrie teaches a revision mechanism for a modeling system, the revision mechanism being configured:

to record revisions of the model of the scenario including the definition of a hierarchy of revision entries, each revision entry including pointers to adjoining entries in the hierarchy and including a definition of a previous value of a property and an current value of a property [hierarchy of revision entries corresponding to Fig. 6 “Standard Decision Dependencies” at page 141 with properties corresponding to data held in “slots” described at page 139 column 2 through page 140 column 1]; and

in response to selection of a revision of the model of the scenario, to access the linked series of revision entries selectively to remove and to reintroduce the selected revision for the current version of the model [model revisions include selective removal and reintroduction of revisions corresponding to “backtracking” performed by Redux’ as part of model constraint handling; see Section 2.4 “Optimality and Backtracking” at page 137 column 2 through page 139 column 1 and Section 3.3 “Behavior” at page 142].

Therefore, claim 56 is anticipated by Petrie.

Applicants’ Arguments

5. Applicants make the following arguments in the Response at page 3:

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5.1 Regarding the rejection under Section 101, Applicants argue that: "The claimed invention of this application is not double patenting of the subject matter of the parent application/patent."

5.2 Regarding the rejection under Section 102, Applicants argue that: "The claimed invention of this application is not anticipated by the Examiner's citation(s) of art."

5.3 Regarding the rejection under Section 112, second paragraph Applicants argue that: "The claimed invention meets all the requirements of 35 U.S.C. § 112 for patentability. The claimed invention is enabled and distinctly claimed."

Examiner's Reply

6. Applicants' complete arguments quoted above have been fully considered but are unpersuasive because they are conclusory. Additionally, the lack of specificity in the arguments suggests that the attorney presenting the Response (Paul Grandinetti, Reg. No 30,754) had never reviewed the first Office Action (Paper #8) and possessed no actual knowledge for the basis of the claim rejections in Paper #8, because the Response:

- 1) fails to identify the individual claim to which the rejections are applied and does not even list the claim number corresponding to this pending claims;
- 2) fails to identify any prior art cited in Paper #8; and
- 3) assumes that the prior rejection under Section 101 is a double patenting rejection whereas this prior rejection in Paper #8 is unrelated to a double patenting rejection.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Samuel Broda, whose telephone number is (703) 305-1026. The Examiner can normally be reached on Mondays through Fridays from 8:00 AM – 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kevin Teska, can be reached at (703) 305-9704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'S. Broda'.

**SAMUEL BRODA, ESQ.
PRIMARY EXAMINER**